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EXAMINER

WALLERSON, MARK E

ART UNIT PAPER NUMBER

2626

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/733,433

Applicant(s)

HAINES ET AL.

Examiner

Mark E. Wallerson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 18 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**Part III DETAILED ACTION**

*Notice to Applicant(s)*

1. This action is responsive to the following communications: amendment filed on 4/18/2005.

2. This application has been reconsidered. Claims 1-31 are pending.

*Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. With respect to claims 1, 8, and 15, there is no disclosure in the original specification of “**automatically** composing an electronic message **without human intervention**, the **message** including both the detected first and second status; and **automatically transmitting the electronic message over a network without human intervention**” as claimed in amended claims 1, 8, and 15. If Applicant believes this rejection to be in error, Applicant is requested to provide SPECIFIC support for this subject matter in the original specification.

***Response to Arguments***

5. Applicant's arguments filed 4/18/2005 with regard to the 35 U.S.C. § 112, 1<sup>st</sup> Paragraph rejection have been fully considered but they are not persuasive. Applicant submits that he had possession of the newly added subject matter at the time the patent application was filed. The Examiner maintains that the original specification does not disclose “**automatically** composing an electronic message **without human intervention, the message** including both the detected first and second status; and **automatically transmitting the electronic message over a network without human intervention.**” Accordingly, Applicant did not have possession of this limitation at the time the original specification was filed. The 35 U.S.C. § 112, 1<sup>st</sup> Paragraph rejection is therefore made **FINAL**.

**PART 1**

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an

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international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1, 2, 4, 5, 6, 7, 8, 9, 11, 12, 13, 14, 15, 16, 18, 19, 20, 21, 22, 23, 26, and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Ohtani (U.S. 6,108,099).

With respect to claims 1, 8, 9, and 15, Ohtani discloses a method of scheduling an event with respect to a hard copy output engine, comprising: detecting a first status (paper out) of a first portion of the hard copy output engine from a first sensor (sensor 13) incorporated in the hard copy output engine; detecting a second status (toner empty) of a second portion of the hard copy output engine from a second sensor (sensor 11) incorporated in the hard copy output engine; automatically composing an electronic message without user intervention (through controllers (processors) 1 or 10) (column 5, line 60 to column 6, line 7). the message including the detected first and second status (figures 6 and 7), and (sending) the electronic message over a network (column 6, lines 1-7).

With regard to claims 2 and 16, Ohtani discloses detecting a toner out status (column 5, lines 53-59).

With respect to claims 4, 11, and 18, Ohtani discloses the email includes information pertaining to whom assigned (figure 6).

With regard to claims 5, 12, and 19, Ohtani discloses detecting toner out (column 3, lines 49-56).

With respect to claims 6, 13, and 20, Ohtani discloses the copy engine is a fax (column 3, lines 49-55).

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With regard to claims 7 and 14, Ohtani discloses transmitting the consumable order includes a consumable order (figure 6).

With respect to claims 21, 22, 23, 26, and 29, Ohtani discloses adding the status to a notification list (column 5, lines 35-48).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3, 10, 17, 24, 25, 27, 28, 30, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohtani in view of Hayward.

With respect to claims 3, 10, 17, 24, 25, 27, 28, 30, and 31, Ohtani differs from claims 3, 10, 17, 24, 25, 28, 30, and 31 in that he does not clearly disclose detecting a first or second status includes detecting a future need for preventative maintenance.

Hayward discloses the method wherein detecting a first or second status includes detecting a future need for preventative maintenance (which reads on Magenta ink level low) (column 5, lines 58-67 and column 7, lines 48-65). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Ohtani wherein a future need for preventative maintenance is given. It would have been obvious to one of ordinary skill

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in the art at the time of the invention to have modified Ohtani by the teaching of Hayward in order to improve the efficiency of the system.

Further with respect to claims 24, 25, 27, 28, 30, and 31, Hayward discloses logging the hours of operation (threshold in time) (column 8, lines 38-44) or the number of pages handled (column 8, lines 45-58) to determine when preventative maintenance is appropriate.

## **PART 2**

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1, 8, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayward (U.S. 6,629,134) in view of Ohtani (U.S. 6,108,099).

With respect to claims 1 and 8, Hayward discloses a method of scheduling an event with respect to a hard copy output engine, comprising: detecting (detect) a first status (the state of the machine) of a first portion (e.g. paper tray empty) of the hard copy output engine (inherent that the peripheral 10 has a hard copy output engine) from a first sensor (sensors 12 or machine state 14) incorporated (includes) in the hard copy output engine (10, and col. 2, lines 8-16); detecting

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(detect) a second status (the state of the machine) of a second portion (inherent that to detect conditions e.g. paper tray empty can have another different condition) of the hard copy output engine (10) from a second sensor (sensors 12 or machine state 14) incorporated in the hard copy output engine (10, and col. 2, lines 8-16); composing (launches reads on composing) an electronic message (e-mail module) the message including the detected first and second status (detect conditions, col. 2, lines 8-16., col. 8, lines 17-23 and column 5, lines 10-18 and column 6, lines 5-57), and (sending) the electronic message over a network (e-mail; col. 8, lines 17-23 and column 6, lines 5-57).

Hayward differs from claims 1 and 8 in that he does not clearly disclose automatically composing an electronic message without human intervention, the message including both the detected first and second status; and automatically transmitting the electronic message over a network without human intervention.

Ohtani discloses an image forming apparatus and management system which automatically composes an electronic message without human intervention (via system controller (1), the message including both the detected first and second status (paper out or paper jam) (figures 6 and 7); and automatically transmitting the electronic message over a network without human intervention (column 6, lines 1-63). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Hayward wherein an email is automatically created and transmitted. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Hayward by the teaching of Ohtani in order to improve the efficiency of the image forming and management system.



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With respect to claims 2, 9, and 16, Hayward discloses detecting a toner low status (column 5, lines 58-67).

With respect to claims 3 and 10, Hayward discloses the method wherein detecting a first or second status includes detecting a future need for preventative maintenance (which reads on Magenta ink level low) (column 5, lines 58-67 and column 7, lines 48-65).

With regard to claims 4, 5, 11, 12, 18, 19, Hayward discloses sensing malfunction (error) conditions and preventative maintenance items (which reads on Magenta ink level low) (column 5, lines 10-18 and column 5, lines 58-67 and column 7, lines 48-65).

Regarding claims 6 and 13, Hayward discloses the method wherein the hard copy output engine is chosen from a group consisting of: facsimile machines, photocopiers and printers (see Fig. 3).

Regarding claims 7 and 14, Hayward discloses the method wherein transmitting the electronic message comprises transmitting an electronic message including a consumable order (col. 8, lines 17-23).

With respect to claims 15 and 23, Hayward discloses a computer implemented control system for a hard copy output engine, the system comprising: a first sensor (sensors 12) coupled (see Fig. 1) to a first portion (conditions e.g. paper tray empty) of the hard copy output engine (inherent that the peripheral 10 has a hard copy output engine), the first sensor (12 or 14) being configured (to detect) to provide a first status (the state of the machine) of the first portion (e.g. paper tray empty; col. 2, lines 8-16): a second sensor (sensors 12 or 14) coupled (see Fig. 1) to a second portion (inherent that to detect conditions e.g. paper tray empty can have another different condition) of the hard copy output engine (10), the second sensor (12) being configured

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(to detect) to provide a second status (the state of the machine) of the second portion (col. 2, lines 8-16), and processing circuitry (firmware 16) coupled (see Fig. 1) to the first and second sensors (sensors 12) and configured to: detect the first status (detect conditions, col. 2, lines 8- 16), detect the second status (detect conditions, col. 2, lines 8-16); composing (launches reads on composing) an electronic message (e-mail module) the message including the detected first and second status (detect conditions, col. 2, lines 8-16., col. 8, lines 17-23 and column 5, lines 10-18 and column 6, lines 5-57), and transmitting (sending) the electronic message over a network without user intervention (e-mail; col. 8, lines 17-23 and column 6, lines 5-57).

Hayward differs from claim 15 in that he does not clearly disclose automatically composing an electronic message without human intervention, the message including both the detected first and second status; and automatically transmitting the electronic message over a network without human intervention.

Ohtani discloses an image forming apparatus and management system which automatically composes an electronic message without human intervention (via system controller (1), the message including both the detected first and second status (paper out or paper jam) (figures 6 and 7); and automatically transmitting the electronic message over a network without human intervention (column 6, lines 1-63). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Hayward wherein an email is automatically created and transmitted. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Hayward by the teaching of Ohtani in order to improve the efficiency of the image forming and management system.

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Regarding claim 17, Hayward discloses the computer implemented control system, wherein the processor is configured to detect a first or second status includes a processor configured to detect a future need for preventative maintenance (which reads on Magenta ink level low) (column 5, lines 58-67 and column 7, lines 48-65).

Regarding claim 20, Hayward discloses the computer implemented control system, wherein the processor configured to detect a first and second status comprises a processor configured to detect a first and second status of a hard copy output engine chosen from a group consisting of: facsimile machines, photocopiers and printers (see Fig. 3).

With respect to claims 21, 22, 26, and 29, Hayward discloses automatically composing an electronic message comprises adding the first and second status to a notification list (column 5, lines 10-14), and adding a notification list generated by a second hard copy engine (the peripheral may be a combination fax, copier and printer) (column 3, lines 44-53, column 6, lines 20-57).

With respect to claims 24, 25, 27, 28, 30, and 31, Hayward discloses logging the hours of operation (threshold in time) (column 8, lines 38-44) or the number of pages handled (column 8, lines 45-58) to determine when preventative maintenance is appropriate.

### ***Response to Arguments***

12. Applicant's arguments with respect to claims 1-31 have been considered but are moot in view of the new ground(s) of rejection.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark E. Wallerson whose telephone number is (571) 272-7470. The examiner can normally be reached on Monday-Friday - 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark E. Wallerson  
Primary Examiner  
Art Unit 2626



MARK WALLERSON  
PRIMARY EXAMINER